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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,539	09/16/2005	Shiro Torizuka	2005-1091A	1477

513 7590 12/23/2008

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EXAMINER	
YANG, JIE	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
12/23/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/541,539	TORIZUKA ET AL.	
	Examiner	Art Unit	
	JIE YANG	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-20 have been amended and claims 1-20 are pending. The amendments do not change the scope of the original claims.

Status of the Precious Rejection

The previous rejections of claims 1, 7, and 8 under 35 U.S.C. 112 second paragraph is withdrawn in view of the amendment filed on 9/12/2008.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujioka et al (JP 09-279233 with machine translation, thereafter JP'233).

JP'233 is applied to the claims 1-10 and 13-20 for the same reason as stated in the previous rejection dated 5/13/2008.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP'233 in view of Sakata et al (JP 2001-214214, thereafter JP'214).

JP'233 in view of JP'214 is applied to the claim 11 for the same reason as stated in the previous rejection dated 5/13/2008.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP'233 in view of Saito (JP 60-200915, thereafter JP'915).

JP'233 in view of JP'915 is applied to the claim 12 for the same reason as stated in the previous rejection dated 5/13/2008.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1-20 of copending application No. 10/557416.

Claims 1-20 of copending application No. 10/557416 is applied to the claims 1-20 for the same reason as stated in the previous rejection dated 5/15/2008.

Response to Arguments

Applicants' arguments filed on 9/12/2008 with respect to claims 1-20 have been fully considered but they are not persuasive.

Applicants argue: the distinctions between Applicants' invention and the teachings of Fujioka are: A) only the total rolling time and total strain have to be controlled in the Applicants' invention, and it is industrially more advantageous compared to Fujioka. B) Fujioka fails to teach or suggest controlling the grain size of the ferrite; in contrast, Applicants have discovered crystal structure control by parameter Z, by using a general strain speed which includes the pass duration. C) in the Applicants' invention, the temperature control of the material between before and after rolling is clearly presented.

In response: as pointed out in the previous office action marked 5/13/2008, Fujioka et al (JP'233) teaches a process of producing a high strength steel comprising the rolling of steel in one or more passes at a temperature of 500-700^{o}C, a strain rate of 0.1-20 s^{-1} and a pass interval of 20 s or less, wherein the steel prior to the step of rolling

has a ferrite microstructure (Abstract, paragraphs [0023]-[0029] and claims 1 and 2 of JP'233), which includes the controlling of rolling time, strain, grain size, and rolling temperature. The Examiner notices the calculated rolling condition parameter Z as taught by Fujioka et al (JP'233) is 14-15 (table 2-3 of JP'233), which is within the claimed range (Z=11 or more—instant claim 1; 12 or more—instant claims 17-20); and the temperature different of 10°C between the start and end of rolling, which is also with in the claimed range of the temperature different (within 100K). From the comparison table in the page 9 of the remarks filed on 9/12/2008, all of the warm rolling conditions taught by Fujioka et al are within or overlap the conditions as recited in the instant invention, which is a *prima facie* of obviousness. MPEP 2144.05 I. Therefore, it would have been obvious to one ordinary skilled in the art to control the proper parameters of warm rolling as taught by JP'233, for example, the total rolling time, total strain, Z value, and/or rolling temperature because JP'233 discloses the same utility throughout the disclosed ranges.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jie Yang whose telephone number is 571-270-1884. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-2721244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JY

/Roy King/
Supervisory Patent Examiner, Art Unit 1793